



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/072,382	02/06/2002	James D. Pravetz	07844-494001	2559

21876 7590 12/28/2005

FISH & RICHARDSON P.C.

P.O. Box 1022

MINNEAPOLIS, MN 55440-1022

EXAMINER

STORK, KYLE R

ART UNIT

PAPER NUMBER

2178

DATE MAILED: 12/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/072,382	PRAVETZ, JAMES D.	
	Examiner	Art Unit	
	Kyle R. Stork	2178	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 October 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This non-final office action is in response to the amendment submitted with the request for continued examination filed 26 October 2005.
2. Claims 1-32 are pending. Claims 1 and 17 are independent claims. The rejection of claims 1-32 under 35 U.S.C. 103 have been withdrawn as necessitated by the amendment.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-8, 11, 13, 17-24, 26-27, and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Parry (US 2003/0062202, filed 28 September 2001) and further in view of Kuo et al. (6873715, 31 January 2002, hereafter Kuo).

As per independent claim 1, Parry discloses a method for signing an electronic document, the method comprising:

- Establishing an electronic signature appearance for an electronic signature, an electronic signature appearance comprising a visual manifestation of a signer's signature on the electronic document (paragraphs 0006 and 0009)
- At the time of signing an electronic document, previewing the electronic signature appearance, where the electronic signature appearance can be edited based on

a user input after previewing the electronic signature appearance and before signing the electronic document (paragraph 0038: Here, the electronic signature can be created, edited, appended, deleted, or verified. Although, previewing of the signature is not specifically disclosed, a signature must be previewed in order for a user to determine if an edit is desired)

- Signing the electronic document with an electronic signature, the electronic signature appearance included in the electronic document (paragraph 0041)

Parry fails to specifically disclose a bounding region for the signature. However, Kuo discloses a bounding region for the signature (Figure 6). It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have combined Kuo with Parry, since it would have allowed for approval of a signature (Kuo: column 12, line 66- column 13, line 21).

As per dependent claim 2, Parry and Kuo disclose the limitations similar to those in claim 1, and the same rejection is incorporated herein. Parry further discloses the method further comprising configuring the electronic signature appearance at the time of the signing the electronic document (paragraph 0038).

As per dependent claim 3, Parry and Kuo disclose the limitations similar to those in claim 2, and the same rejection is incorporated herein. Parry further discloses wherein configuring the electronic signature appearance comprises interacting with a user signing the electronic document (paragraph 0038: Here, editing a signature is interaction with the user signing the electronic document).

As per dependent claim 4, Parry and Kuo disclose the limitations similar to those in claim 2, and the same rejection is incorporated herein. Parry further discloses wherein configuring the electronic signature appearance comprises receiving user input activating controls for controlling textual and graphical elements included in the electronic signature (paragraph 0038: Here, the user is able to manipulate the electronic signature appearance by activating control functions).

As per dependent claim 5, Parry and Kuo disclose the limitations similar to those in claim 4, and the same rejection is incorporated herein. Kuo further discloses control functions comprising one or more of checkboxes and buttons (column 12, line 66- column 13, line 21). It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have combined Kuo with Parry, since it would have allowed for approval of a signature (Kuo: column 12, line 66- column 13, line 21).

As per dependent claim 6, Parry and Kuo disclose the limitations similar to those in claim 4, and the same rejection is incorporated herein. Kuo further discloses wherein previewing the electronic signature appearance includes previewing a display in a configuration dialog box of the electronic signature appearance within the bounding region and the controls for controlling textual and graphic elements (column 12, line 66- column 13, line 21). It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have combined Kuo with Parry, since it would have allowed for simultaneous display of a signature and the ability to approve of a signature (Kuo: column 12, line 66- column 13, line 21).

As per dependent claim 7, Parry and Kuo disclose the limitations similar to those in claim 1, and the same rejection is incorporated herein. Kuo further discloses wherein previewing the electronic signature appearance includes displaying the electronic signature appearance within the bounding region on a display of the electronic document (column 12, line 66- column 13, line 21). It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have combined Kuo with Parry, since it would have allowed for approval of a signature (Kuo: column 12, line 66- column 13, line 21).

As per dependent claim 8, Parry and Kuo disclose the limitations similar to those in claim 1, and the same rejection is incorporated herein. Parry further discloses including in the electronic signature appearance textual elements automatically copied from the certificate of a user signing the electronic document (paragraphs 0006 and 0009: Here, the user signature is included within the document that the user signs).

As per dependent claim 10, Parry and Kuo disclose the limitations similar to those in claim 1, and the same rejection is incorporated herein. Parry further disclose wherein establishing an electronic signature appearance comprises interacting with a user to create an electronic signature (paragraphs 0006, 0009, and 0038: Here, a user creates a signature. The electronic signature module then interacts with the user to allow manipulations of the signature)

As per dependent claim 11, Parry and Kuo disclose the limitations similar to those in claim 1, and the same rejection is incorporated herein. Parry further discloses the method wherein establishing an electronic signature appearance comprises

receiving an electronic signature appearance pre-configured by an author of the electronic document to be signed (Figure 4: Here, a user pre-signs a document before the electronic signature is created).

As per dependent claim 13, Parry and Kuo disclose the limitations similar to those in claim 1, and the same rejection is incorporated herein. Kuo further discloses wherein previewing the electronic signature appearance comprises previewing the electronic signature appearance configured to fit within the bounding region (Figure 6: Here, the signature is entirely displayed within the bounding region). It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have combined Kuo with Parry since it would have allowed a user to ensure that the entire signature is captured.

As per independent claim 17, the applicant discloses the limitations substantially similar to those in claim 1. Claim 17 is similarly rejected.

As per dependent claim 18, the applicant discloses the limitations substantially similar to those in claim 2. Claim 18 is similarly rejected.

As per dependent claim 19, the applicant discloses the limitations substantially similar to those in claim 3. Claim 19 is similarly rejected.

As per dependent claim 20, the applicant discloses the limitations substantially similar to those in claim 4. Claim 20 is similarly rejected.

As per dependent claim 21, the applicant discloses the limitations substantially similar to those in claim 5. Claim 21 is similarly rejected.

As per dependent claim 22, the applicant discloses the limitations substantially similar to those in claim 6. Claim 22 is similarly rejected.

As per dependent claim 23, the applicant discloses the limitations substantially similar to those in claim 7. Claim 23 is similarly rejected.

As per dependent claim 24, the applicant discloses the limitations substantially similar to those in claim 8. Claim 24 is similarly rejected.

As per dependent claim 26, the applicant discloses the limitations substantially similar to those in claim 10. Claim 26 is similarly rejected.

As per dependent claim 27, the applicant discloses the limitations substantially similar to those in claim 11. Claim 27 is similarly rejected.

As per dependent claim 29 the applicant discloses the limitations substantially similar to those in claim 13. Claim 29 is similarly rejected.

5. Claims 9 and are rejected under 35 U.S.C. 103(a) as being unpatentable over Parry and Kuo, and further in view of "User's Guide: Microsoft Word", Microsoft Corporation, Version 6.0, 1993-1994, hereinafter Microsoft Corporation.

As per dependent claim 9, Parry and Kuo disclose the limitations similar to those in claim 1, and the same rejection is incorporated herein Parry fails to specifically disclose that establishing an electronic signature appearance comprises receiving user input selecting an electronic signature appearance from one or more existing electronic signature appearances. However, on page 212 of Microsoft Corporation, Microsoft Corporation sets forth a selection of appearances between multiple templates to provide

Art Unit: 2178

a flexible choice of appearances. It would have been obvious to one of ordinary skill in the art at the time of the invention to select an electronic signature appearance from one or more existing electronic signature appearances to provide a flexible choice of appearances.

As per dependent claim 25, it is a computer program product that performs the method of claim 9 and is rejected under similar rationale.

6. Claims 12, 14, 28 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Parry and Kuo, and further in view of Neff et al (US 6751780, filed 1 October 1998, hereafter Neff).

As per dependent claim 12, Parry and Kuo disclose the limitations similar to those in claim 1, and the same rejection is incorporated herein. Parry fails to specifically disclose that determining a bounding region on the electronic document for the electronic signature appearance comprises interacting with a user signing the electronic document to establish the bounding region. However, Neff discloses establishing a boundary using drag and drop in col. 5, lines 35-55. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Neff with Parry and Kuo since it would have generated a user-friendly method for establishing bounding regions.

As per dependent claim 14, Parry and Kuo disclose the limitations similar to those in claim 1, and the same rejection is incorporated herein. Parry fails to specifically disclose determining the bounding region on the electronic document for the

electronic signature appearance comprises establishing a bounding region pre-set by an author of the electronic document. However, Neff discloses establishing a boundary using drag and drop in col. 5, lines 35-55. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Neff with Wang, Lewis, and Fukuzaki because drag and drop would have enhanced their inventions because it is a user-friendly method for establishing bounding regions. Further, it was notoriously well known in the art at the time of the invention that interactions such as establishing a boundary may be done in advance to save time at runtime. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to use a pre-set bounding region in order to save time at runtime.

As per dependent claim 28, it is a computer program product that performs the method of claim 12 and is rejected under similar rationale.

As per dependent claim 30, it is a computer program product that performs the method of claim 14 and is rejected under similar rationale.

7. Claims 15-16 and 31-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Parry and Kuo, and further in view of Rubin (US 6654009 filed 23 May 2001).

As per dependent claim 15, Parry and Kuo disclose the limitations similar to those in claim 1, and the same rejection is incorporated herein. Parry fails to specifically disclose determining an optimal layout of the electronic signature appearance based on the dimensions of the bounding region. However, Rubin in col. 3,

lines 15-40 discloses finding a layout which is optimized based on the bounding region. It would have been obvious to one of ordinary skill in the art at the time of the invention to find a layout which is optimized based on the bounding region because it would be visually appealing.

As per dependent claim 16, Parry and Kuo disclose the limitations similar to those in claim 1, and the same rejection is incorporated herein. Parry fails to disclose determining optimal dimensions of the bounding region based on the electronic signature appearance. However, Rubin, in the Abstract, lines 1-15, discloses optimizing region size based on format. It would have been obvious to one of ordinary skill in the art at the time of the invention to optimize region size based on format because it would provide an ideal method of arranging entities two-dimensionally that would reflect the requirements of the format, which would be visually appealing, (see col. 1, lines 25-30).

As per dependent claim 31, it is a computer program product that performs the method of claim 15 and is rejected under similar rationale.

As per dependent claim 32, it is a computer program product that performs the method of claim 16 and is rejected under similar rationale.

Response to Arguments

8. Applicant's arguments with respect to claims 1-32 have been considered but are moot in view of the new ground(s) of rejection.

The Parry and Kuo references have been added to address the applicant's amended limitations.

Conclusion

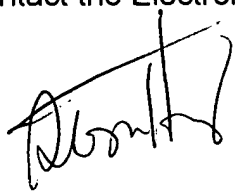
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kyle R. Stork whose telephone number is (571) 272-4130. The examiner can normally be reached on Monday-Friday (8:00-4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong can be reached on (571) 272-4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Kyle Stork
Patent Examiner
Art Unit 2178

krS



STEPHEN HONG
SUPERVISORY PATENT EXAMINER